

23026 U.S. PTO
022404

PATENT
Docket No. 249.P2

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

22858 U.S. PTO
10/785497
022404

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of

Inventor(s): Mark W. Becker, Harlan H. Chapman, Tomas Cihlar, Eugene J. Eisenberg, Gong-Xin He, Michael R. Kernan, William A. Lee, Ernest J. Prisbe, John C. Rohloff and Mark L. Sparacino

For (title): PRODRUGS OF PHOSPHONATE NUCLEOTIDE ANALOGUES AND METHODS FOR SELECTING AND MAKING SAME

1. Type of Application

This new application is for a(n) (check one applicable item below):

- ☐ Original
☐ Design
☐ Divisional
☒ Continuation
☐ Continuation-in-part (CIP)

2. Benefit of Prior Application(s)

Any prior applications are hereby incorporated by reference into the patent application filed herewith.

A. Relate Back

☒ Amend the specification by inserting, before the first line, the following sentence(s):

(1) 35 U.S.C. 119(e)

☐ "This application claims the benefit of U.S. Provisional Application(s) No(s).
_____ filed _____

(2)(a) 35 U.S.C. 120, 121 and 365(c)

☒ "This application is a
☒ continuation
☐ continuation-in-part
☐ divisional

of copending application(s)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this "New Application Transmittal" and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date February 24, 2004 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number E7382657783US addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Robin Torres

(Type or print name of person mailing paper)

Robin Torres
(Signature of person mailing paper)

☒ application number U.S.S.N. 09/909,560 filed July 20, 2001, which claims the benefit of U.S. Provisional Application No. 60/220,021, filed July 21, 2000.

(2)(b) ☐ "Application number _____ filed _____
claims the benefit of U.S. Provisional Application No. _____."

B. Relate Back--35 U.S.C. 119 Priority Claim

This or a prior U.S. application(s), identified above in Item 2a, claim(s) foreign priority(ies) as follows:

Country	Appl. No.	Filed on
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C. Maintenance of Copendency of Prior Application

☒ Extension of time and/or response in the copending **prior** application extended the time for response until February 26, 2003.

☒ A copy of the petition filed in the copending prior application is attached.

☐ A Conditional Petition for Extension of Time was filed in the copending prior application.

D. Abandonment of Prior Application

☐ Please abandon the prior application at a time (1) while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and (2) when this application is granted a filing date, whereby this application is copending with said prior application.

E. Notification in Parent Application of This Filing

☐ A notification of the filing of this

- ☐ continuation
- ☐ continuation-in-part
- ☐ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

3. Papers Enclosed Which Are Required for Filing Date Under 37 CFR 1.53

(b) (Regular) or 37 CFR 1.153 (Design) Application

<u>51</u>	Pages of specification
<u>1</u>	Pages of claims
<u>1</u>	Pages of Abstract
<u> </u>	Sheets of drawing
<input type="checkbox"/>	formal
<input type="checkbox"/>	informal

4. **Declaration or Oath**

- ☒ Enclosed
☐ executed by (check **all** applicable boxes)
☐ inventor(s).
☐ legal representative of inventor(s). 37 CFR 1.42 or 1.43
☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
☐ this is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See item 14 below for fee.
☐ Not enclosed.
☐ Application is made by a person authorized under 37 CFR 1.41(c) on behalf of **all** the above named inventor(s).
☐ Showing that the filing is authorized.

5. **Inventorship Statement**

The inventorship for all the claims in this application are:

- ☐ The same
☐ Are not the same.

6. **Language**

- ☒ English
☐ non-English
☐ the attached translation is a verified translation. 37 CFR 1.52 (d).

7. **Assignment**

- ☒ An assignment of the invention to:
GILEAD SCIENCES, INC.
☐ is attached.
☐ A separate "RECORDATION FORM COVER SHEET" is also attached.
☐ A separate FORM PTO 1906 is also attached.
☒ will follow.

8. **Certified Copy**

Certified copy(ies) of application(s)

(country)	(application no.)	(filed)
from which priority is claimed		
<input type="checkbox"/> is(are) attached.		
<input type="checkbox"/> will follow.		

9. **Amendments**

- ☐ There is provided herewith a Petition to Suspend Prosecution for the Time Necessary to File An Amendment
- ☐ Cancel in this application original claims - _____ before calculating the filing fee.
- ☐ Claims added by preliminary amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application. Fees for claims, if any, added by way of the preliminary amendment have been included in the calculation below.

10. Additional Papers Enclosed

- ☐ Preliminary Amendment
☐ Information Disclosure Statement (37 CFR 1.98)
☐ Form PTO-1449
☐ Citations
☐ Declaration of Biological Deposit
☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
☐ Other _____

11. Fee Calculation (37 CFR 1.16)**A. ☒ Utility application**

CLAIMS AS FILED					
	Number filed		Number Extra	Rate	Basic Fee 37 CFR 1.16 (a) \$770.00
Total Claims (37 CFR 1.16 (c))	1	- 20 =	0	X \$18.00	
Independent Claims (37 CFR 1.16 (b))	1	- 3 =	0	X \$86.00	
Multiple dependent claim(s), if any (37 CFR 1.16 (d))				X \$290.00	
<input type="checkbox"/> Amendment cancelling extra claims enclosed. <input type="checkbox"/> Amendment deleting multiple-dependencies enclosed. <input type="checkbox"/> Fee for extra claims is not being paid at this time.					
Filing Fee Calculation					\$ 770.00

B. ☐ Design application

(\$330.00---37 CFR 1.16 (f))

Filing Fee Calculation

\$

12. Small Entity Statement(s)

- ☐ Verified Statement(s) that this is a filing by a small entity under 37 CFR 1.9 and 1.27 is(are) attached.

Filing Fee Calculation (50% of A or B above)

- ☐ Applicant has established small entity status by the filing of a statement in parent application _____ on _____.

- ☐ A copy of the statement previously filed is included.

13. Request for International-Type Search (37 CFR 1.104 (d))

- ☐ Please prepare an international-type search report for this application at the time when national examination on the merits take place.

14. Fee Payment Being Made At This Time

- ☐ Not Enclosed

- ☐ No filing fee is to be paid at this time.

- ☒ Enclosed

- ☒ basic filing fee

\$ 770.00

- ☐ recording assignment (\$40.00; 37 CFR 1.21 (h))

- ☐ petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached. (\$130.00; 37 CFR 1.47 and 1.17 (h))
- ☐ for processing an application with a specification in a non-English language. (\$130.00; 37 CFR 1.52(d) and 1.17 (k))
- ☐ processing and retention fee (\$130.00; 37 CFR 1.53 (d) and 1.21 (l))
- ☐ fee for international-type search report (\$40.00; 37 CFR 1.21 (e)).

Total fees enclosed

\$ 770.00

15. Method of Payment of Fees

- ☐ Check in the amount of
- ☒ Charge Account No. 07-1250 in the amount of
- A duplicate of this transmittal is attached.

\$ 770.00

16. Power of Attorney

- ☒ The power of attorney in the prior application is to

Mark L. Bosse
Max D. Hensley

35,071
27,043

- A. ☒ The power appears in the original papers in the prior application (copy is enclosed).
- B. ☒ Address all future communications to:

**Mark L. Bosse
Gilead Sciences, Inc.
333 Lakeside Drive
Foster City, CA 94404**

17. Contingent Petition for Extension of Time

If a paper is untimely filed in the subject application by applicant(s) or her/his/their representative, the Commissioner is hereby petitioned under 37 C.F.R. §1.136(a) for the minimum extension of time required to make said paper timely.

18. Authorization to Charge Additional Fees

- ☒ The Commissioner is hereby authorized by this document to charge any additional fees which may be required by this paper and during the entire pendency of this application to Account No. 07-1250, except the issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b).

19. Instructions as to Overpayment

- ☒ credit Account No. 07-1250
- ☐ refund

Reg. No. 35,071

Tel. No.: (650) 522-5569

Customer No. 25000


SIGNATURE OF ATTORNEY

Mark L. Bosse
Type or print name of attorney
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Foster City, CA 94404